Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 2600
Application No.: 09/803,243
Paper Dated: November 12, 2008
Attorney Docket No.: 5882-083473

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.   :   09/803,243   Confirmation No: 7058

Applicant   :   Liwerant et al.

Filed   :   March 9, 2001

Title   :   **Sharing a Streaming Video**

Group Art Unit   :   2623

Examiner   :   Dominic D. SALTARELLI

Customer No.   :   28289

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AMENDMENT

Sir:

In response to the Final Office Action of May 13, 2008, Applicants hereby submit a Request for Continued Examination, a three-month Petition for Extension of Time, a Revocation of Power of Attorney with Statement Under 37 CFR §3.73(b), and the following amendments and remarks.

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks begin on page 8 of this paper.

I hereby certify that this correspondence is being electronically submitted to the United States Patent and Trademark Office on November 12, 2008.

Lisa A. Miller
(Name of Person Submitting Paper)

_____   11/12/2008
Signature   Date

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AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims

Claim 1 (Currently Amended):   A method of sharing a video segment over a computer network, the network comprising a receiving computer and a plurality of other computers including a destination computer, the method comprising the steps of:

(a)   receiving at the receiving computer the video segment and an election to share with an authorized user the video segment as a greeting ~~card~~ sent over the computer network from one of the plurality of other computers;

(b)   performing automatically at the receiving computer, in direct response to a command received over the network, the steps of:

(b1)   ~~assuring that~~ converting the video segment ~~is in~~ into a streaming video format;

(b2)   creating at least an identification tag for ~~the~~ identifying the video segment ~~to identify the video segment~~, the identification tag ~~including~~ consisting of a uniform resource locator (URL) identifying a network-accessible location of the video segment;

(b3)   storing the video segment under the control of the receiving computer in the streaming video format at the network-accessible location; and

(b4)   ~~returning~~ transmitting the identification tag to the one of the plurality of other computers in an electronic mail communication;

(c)   receiving ~~the identification tag~~ at the receiving computer a request for the video segment by identification of the network-accessible location; and

(d)   in response to the receipt of the ~~identification tag~~ request at the receiving computer and verification at the receiving computer that the ~~identification tag~~ request was sent from the authorized user ~~at the receiving computer~~, streaming the video segment in the streaming video format over the network to the destination computer.

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Claim 2 (Original):   The method of claim 1, further comprising causing the video segment to be displayed at the destination computer.

Claim 3 (Original):   The method of claim 1, wherein the video segment comprises an image with associated audio information.

Claims 4-5 (Cancelled)

Claim 6 (Original):   The method of claim 1, wherein the computer network comprises a cellular communication connection.

Claim 7 (Original):   The method of claim 1, wherein the computer network comprises a wireless networking connection.

Claims 8-12 (Cancelled)

Claim 13 (Currently Amended):   The method of claim 1, wherein step (a) comprises receiving the video segment which is sent in association with an upload form residing on a World Wide Web (Web) page.

Claim 14 (Original): The method of claim 1, wherein step (a) comprises receiving the video segment which is sent in association with a File Transfer Protocol (FTP) transfer.

Claim 15 (Original): The method of claim 1, wherein step (a) comprises receiving the video segment which includes information supplied by a sender at the one of the plurality of other computers.

Claim 16 (Original): The method of claim 15, where the information comprises information describing a streaming format into which the receiving computer converts the video segment.

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Claim 17 (Original): The method of claim 15, wherein the information comprises an identification of the sender.

Claim 18 (Original): The method of claim 17, wherein the identification of the sender comprises a proper name.

Claim 19 (Original): The method of claim 17, wherein the identification of the sender comprises a username.

Claim 20 (Original): The method of claim 17, wherein the identification of the sender comprises a password.

Claim 21 (Original): The method of claim 15, wherein the information comprises a return address of the sender.

Claim 22 (Original): The method of claim 21, wherein the return address comprises an e-mail address.

Claim 23.(Original): The method of claim 15, wherein the information comprises an identifier of the video segment.

Claim 24 (Original): The method of claim 23, wherein the identifier comprises a title.

Claim 25 (Original): The method of claim 23, wherein the identifier comprises a name.

Claim 26 (Original): The method of claim 23, wherein the identifier comprises a date the video segment was produced.

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Claim 27 (Original): The method of claim 23, wherein the identifier comprises a location relating to the video segment.

Claim 28 (Original): The method of claim 23, wherein the identifier comprises a subject relating to the video segment.

Claim 29 (Original): The method of claim 15, wherein the information comprises a comment about the video segment.

Claim 30 (Original): The method of claim 15, wherein the information comprises a period of time during which the video segment will be available.

Claim 31 (Original): The method of claim 15, wherein the information comprises information relating to a priority order of processing a video segment by the receiving computer.

Claim 32 (Original): The method of claim 15, wherein the information comprises an instruction for transmittal of a response.

Claim 33 (Original): The method of claim 32, wherein the instruction comprises a formatting instruction.

Claim 34 (Original): The method of claim 32, wherein the instruction comprises a speed of transmission.

Claim 35 (Original): The method of claim 32, wherein the instruction comprises a transmission protocol to be used.

Claim 36 (Original): The method of claim 32, wherein the instruction comprises a format of a physical medium to be used in sending a physical machine-readable copy of the video segment.

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Claim 37 (Original): The method of claim 32, wherein the instruction comprises a resolution of the video segment.

Claim 38 (Original): The method of claim 32, wherein the instruction comprises an image quality of the video segment.

Claim 39 (Original): The method of claim 32, wherein the instruction comprises a display format of the video segment on a destination computer.

Claim 40 (Original): The method of claim 15, wherein the information comprises financial information.

Claim 41 (Original): The method of claim 40, wherein the financial information comprises a credit card number.

Claim 42 (Original): The method of claim 40, wherein the financial information comprises a financial account identifier.

Claims 43-84 (Cancelled)

Claim 85 (Currently Amended): A method for operating a video-sharing server on a network comprising the steps of:

receiving a video, an election to share with an authorized user the video as a greeting card, and an electronic mail address of the authorized user;

confirming that converting the video is in into a streaming video format;

storing the video at a network-accessible location;

generating an identification tag including a link to the network-accessible location;

generating an electronic communication formed as a the greeting card containing the link and addressed to the electronic mail address; and

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transmitting the electronic communication <u>to the authorized user</u>.

Claim 86 (Previously Presented):   The   method   of   claim   85   wherein receiving the video includes at least one of receiving an FTP upload, receiving an HTTP post, receiving an electronic mail, and receiving an instant message.

Claim 87 (Previously Presented):   The   method   of   claim   85   further comprising publishing the link to a Web page.

Claim 88 (Previously Presented):   The   method   of   claim   85   further comprising receiving a mailing list including a plurality of e-mail addresses and transmitting the electronic message to the plurality of e-mail addresses.

Claim 89 (Previously Presented):   The method of claim 85 wherein link includes one or more of a path, a URL, an IP address, and a file name.

Claim 90 (Currently Amended):   A method for operating a video-sharing server on a network comprising <u>the steps of</u>:
  receiving a video, an election to share with an authorized user the video as a greeting ~~card~~, and a cellular phone address of the authorized user;
  ~~confirming that~~ <u>converting</u> the video ~~is in~~ <u>into</u> a streaming video format;
  storing the video at a network-accessible location;
  generating an identification tag including a link to the network-accessible location;
  generating an electronic communication formed as the greeting ~~card~~ and containing the link and addressed to the cellular phone address; and
  transmitting the electronic communication.

Claim 91 (New):   The method of claim 1, wherein the greeting is a greeting card.

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REMARKS

Claims 1-3, 6-7, 13-42, and 85-90 were pending in this application. Independent claim 1 has been amended to require the identification tag to be a uniform resource locator identifying a network-accessible location of the video segment. Claim 1 has also been amended to require a request for video segment by identification of the network-accessible location be received at the receiving computer and that it is in response to this request the streaming video is transmitted. Independent claims 1, 85, and 90 have been amended to require that the received video be converted into a streaming video format. Independent claims 1, 85, and 90 have been amended to remove the "greeting card" limitation and new dependent claim 91, which now contains this limitation, has been added. Claims 13, 85, and 90 have been amended for grammatical and consistency purposes. No claims have been cancelled. No new subject matter is believed to have been added by these amendments. Therefore, claims 1-3, 6-7, 13-42, and 85-91 remain in this application.

35 U.S.C. §103 Rejections

Claims 1-3, 6, 7, 13-15, 17, 30, 32, 36, 40-42, 85, 86, 88, and 89 stand rejected under 35 U.S.C. §103(a) for obviousness based upon U.S. Patent No. 6,774,926 to Ellis et al. in view of non-patent literature "Streaming Email" and further in view of U.S. Patent No. 5,712,903 to Batholomew et al. Claim 90 stands rejected for obviousness based upon the aforementioned references further in view of U.S. Patent No. 5,422,656 to Allard et al. Accordingly, the independent claims 1, 85, and 90 are rejected in part under common prior art, namely, the Ellis patent and the "Streaming Email" publication.

The Examiner acknowledges that the Ellis patent fails to disclose the claimed automatic steps being performed directly in response to the received command, the identification tag including a network-accessible location where the video segment is stored, returning the identification tag in an electronic mail communication, and wherein the video segment is shared as a greeting card. The Examiner then asserts that these claimed aspects are disclosed in the "Streaming Email" publication and the Bartholomew patent and that it would have been obvious to combine the teachings of these references "for the benefit of ensuring very quick delivery of a video enabled message to specific desired recipients."

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Applicants respectfully offer that the Examiner's obviousness analysis is insufficient to sustain a prima facie case of obviousness. Because the Examiner has not relied on a teaching, suggestion, or motivation analysis the Supreme Court precedent still requires that the obviousness rejection still be well-supported. In other words, the obviousness analysis "should be made explicit" in that there "must be some articulated reasoning with rational underpinning to support the legal conclusion of obviousness." A rejection "on obviousness grounds cannot be sustained by mere conclusory statements." (*KSR v. Teleflex*, 550 U.S. ___ at 14, 127 S. Ct. 1727 (2007), citing *In re Kahn*, 441 F.3d 977 (Fed Cir . 2006)). The Examiner's benefit-related statement fails to address why it would be obvious to combine *each* of the various claim limitations purportedly appearing in the "Streaming Email" publication (absent in the Ellis patent) with the claim limitations purportedly disclosed in the Ellis patent. The Examiner simply provides a blanket statement that does not satisfy the articulated reasoning requirement and, absent such an articulated reasoning, it is apparent that the Examiner is using impermissible hindsight reconstruction to "pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (*In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)).

The Ellis system provides a viewer with a program guide or other interactive television application from which the viewer may view a personal channel showcase screen. (*See* Abstract; FIGS. 11 and 12). As disclosed, selection of videos is done via a proprietary menu based system provided by a cable provider or other television distribution provider. The Examiner equates the claimed identification tag to identification information associated with each video that is selectable on the program guide presented to the viewer. Applicants have amended claim 1 to clarify that the identification tag consists of a uniform resource locator (URL). As is known in the art, a URL may be embodied as a hyperlink, which provides a functional aspect thereto, independent of display medium or operating platform. In other words, a URL is treated as a clickable or activatable hyperlink that includes all necessary access information (i.e., network location, actual file, etc.) self-contained therein. The Ellis patent fails to disclose a URL that is transmitted to various computers for the purpose of indicating to a remote system the selection of a video. Furthermore, it would not make sense to utilize hyperlinks in the Ellis system when selection of the video is done via a proprietary menu based system that is not disclosed as operating in the context of a hypertext

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transfer protocol implementation, as would be consistent when utilizing a URL. In fact, the Ellis system teaches away from utilizing a URL in the proprietary menu based system due to the fact that the Ellis system provides for the separate ability, via the proprietary menu, to launch a web browser to allow the viewer to browse the Internet (*See* column 10, lines 39-41). Thus, any teachings of URL usage would be limited to URLs accessed within the browser, which has no bearing on video selection.

The Ellis system also relates to a personal television channel system in which uploaded videos are viewed in an on-demand context (column 7, lines 44-45; column 8, lines 24-25). In other words, a potential viewer is required to actively seek out a desired video and indicate to the system that they wish to view that particular video. Specifically, the Ellis system utilizes a dedicated channel to show either a listing of scheduled programming or a program guide (See column 8, lines 37-60). In contrast, the present invention does not rely on a viewer to seek out any videos, as any such "videos" (i.e., the URL) are transmitted from a user to a recipient in email space. In other words, the present invention operates in a targeted recipient email communication space, whereas the Ellis system operates in a non-specified/non-targeted broadcast space. Although the "Streaming Email" publication discloses email communication, the Examiner has not provided any reasoning as to why it would be obvious to combine the aspects of a non-targeted broadcast system with that of a targeted recipient email communication system. Although Applicants acknowledge that an email system provides "quick delivery… to specific recipients", the intent of the Ellis system is to allow viewing in a mass broadcast context or scheduled delivery, and not to specific recipients. Thus, the goals of the two systems are incongruous and would not lend themselves to being combined.

The independent claims require that the received video be converted into a streaming video format at the receiving computer (i.e., server; not recipient's computer, which is designated as "the destination computer" in the claims) and that such conversion be performed in direct response to a command received over the network. The Examiner states that this automation for conversion at the Ellis system would have been obvious in view of the teachings of the "Streaming Email" publication. Applicants respectfully disagree. Specifically, as discussed in the "Streaming Email" publication, the Video Express Email program requires installation of a video player by a recipient to be able to view a video

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transmitted by a user (i.e., the sender) of the Video Express Email program (*See* page 311, #5; page 313, FIG. 18.5; page 309, first paragraph); the sender is given the option to send the required player along with the video to the recipient. In contrast, the preset invention converts video at a server end after receipt of that video, thereby overcoming the need to install a specialized viewer as discussed in the "Streaming Email" publication with respect to the Video Express Email program. When interpreting the patentability of a claim, the law requires that a reference be considered for all of its teachings, *including disclosure that diverges and teaches away from the invention at hand* as well as disclosures that point toward and teach the invention. (*In re Dow Chem. Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988)) (*emphasis added*). Accordingly, the teaching of the "Streaming Email" publication must also include the requirement that specialized software configured to view the received proprietary video file be transmitted to and be installed at a recipient's end prior to allowing the recipient to view the video file. First of all, the streaming data in the Ellis system is disclosed to be industry standard MPEG streaming data (*See* column 8, line 34), a non-proprietary video format, which does not require specialized software to view it. Second, the teachings of the "Streaming Email" publication would require the server in the Ellis system to transmit a user executable software application that the user must install prior to viewing a video. Accordingly, based on the fact that the teachings of the "Streaming Email" publication, as a whole, teach away from a combination with the method disclosed in the Ellis patent, Applicants respectfully assert that a prima facie case of obviousness cannot be made.

For the foregoing reasons, Applicants believe that the subject matter of amended independent claim 1 and independent claims 85 and 90 is not rendered obvious by the prior art of record. Reconsideration of the rejections of these claims and the claims depending therefrom is respectfully requested.

The lack of specifically addressing the Examiner's arguments in view of the disclosure of the Batholomew patent or any other cited reference in the Office Action is neither to be construed as a waiver of Applicants' right to address the relevance or lack thereof of these references in the future, nor is it to be construed as an indication of assent to the merit of the Examiner's arguments set forth with respect to these references as applied to the claims.

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REVOCATION OF POWER OF ATTORNEY

Applicants hereby submit an executed Revocation of Power of Attorney with a New Power of Attorney and Change of Correspondence Address document along with a Statement Under 37 CFR 3.73(b). Applicants respectfully request that the new practitioners and correspondence address be made of record such that all future correspondence will be directed to Applicants' practitioners, namely, The Webb Law Firm.

CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-3, 6-7, 13-42, and 85-91 are respectfully requested.

Respectfully submitted,

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